

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-21 are all the claims pending in the application. In response to the Office Action, Applicant respectfully submits that the claims define patentable subject matter.

I. Preliminary Matters

Applicant notes that in the Office Action Summary, the Examiner checked Box 2(a) to indicate that the Office Action is final. However, MPEP 706.07(a) states “[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement”. In the present Office Action, the Examiner introduced a new ground of rejection in the form of a 35 U.S.C. § 112, rejection, which was not necessitated by Applicant's Amendment. Applicant conducted a telephone interview with the Examiner on July 24, 2007 in order to clarify this discrepancy. The Examiner indicated that the Office Action is indeed non-final.

Applicant thanks the Examiner for fully acknowledging receipt of a certified copy of the Foreign Priority document which was filed in the U.S. Patent and Trademark Office on November 7, 2003.

Applicant notes that the Examiner has not indicated whether the Objections to the Specification and the Rejections under 35 U.S.C. § 112, second paragraph, made in the Office Action dated February 8, 2007 have been removed in response to Applicant's arguments made in the Amendment filed on May 8, 2007. For purposes of examination, Applicant will assume that the Objections to the Specification and the Rejections under 35 U.S.C. § 112, second paragraph, made in the Office Action dated February 8, 2007 have been removed by the Examiner.

The Examiner has rejected claims 3 and 8 under 35 U.S.C. § 112, second paragraph, because some terms allegedly lack antecedent basis. By this Amendment, Applicant has amended claims 3 and 8 in order to improve clarity. Accordingly, the Examiner is requested to remove the § 112 rejections.

II. Analysis

Claims 1-8, 10-12, 14, and 16 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Torikka et al. (U.S. Patent No. 6,937,577, hereafter “Torikka”). Claims 9, 13, 15, and 17-21 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Torikka in view of Karabinis (U.S. Patent No. 6,856,787). Applicant respectfully traverses the rejections

In the Amendment filed on May 8, 2007, Applicant submitted that there is no teaching or suggestion in Torikka of a data management device which includes “control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station” as recited in independent claim 1. Applicant further submitted that it was unclear from the rejection what the Examiner considered to be the claimed “data management device.”

In response, the Examiner asserts:

Torikka teaches comprehensive system for telecommunication that provides data management device with a control unit that determines the system requirement for the allocation of resources due to a change in the functionality of the system resources (see e.g. col. 9, lines 32-54). Therefore, Torikka still meets the scope of the claim language as currently recited.²

² Page 10 of the Office Action dated June 14, 2007.

Applicant respectfully submits that this newly cited portion of Torikka fails to teach or suggest the claimed “data management device”, and in fact, has little or no relevance to the claimed invention.

The Examiner now appears to take the position that the claimed “data management device” allegedly reads on the column 9, lines 32-54 disclosure of Torikka. However, this cited portion of Torikka merely discloses an operation for changing the functionality of system resources in a telecommunications network. A control unit determines that the telecommunication system requires a different allocation of resources, and reconfigures several Asynchronous transfer mode Multiplication Boards (AMBs), so that the necessary changes are performed.

Applicant respectfully submits that nothing in this cited portion (or any other portion) of Torikka teaches or suggests a data management device which includes control means configured to be coupled to a traffic source, and which takes local control, on command, of at least a portion of the resources of a base station, instead of a terrestrial node, to enable transfer of data between the traffic source and the base station, as required by independent claim 1.

The Examiner further asserts that:

It is the Examiner’s position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant’s disclosed invention in manner, which distinguishes over the prior art.³

The Examiner’s position is not understood. Applicant’s invention is entitled “A Device for taking Control of Resources in a Communication Network in order to insert traffic”.

³ Page 10 of the Office Action dated June 14, 2007.

Applicant's original specification (for example, FIGs. 1-8) discloses a data management device (D) which comprises control means (M) configured to be coupled to a traffic source (TS), and which takes control of at least a portion of the resources of a base station (for example, pages 10-11 of the original specification), instead of a terrestrial node (for example, page 12 of the original specification), and enables the transfer of data from the traffic source to the base station (for example, page 12 of the original specification).

Claim 1 recites:

A data management device for a communication installation including at least one base station having resources and at least one terrestrial node connected to a core network and to said base station to control its resources via an interface, the device comprising control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station.

Accordingly, Applicant respectfully submits it is quite clear that claim 1 is drawn to limitations which define the operation and apparatus of Applicant's disclosed invention. Applicant further submits that the claimed invention clearly distinguishes over the cited prior art, since there is no teaching or suggestion in the cited prior art of a data management device which includes "control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station" as recited in independent claim 1.

In the response, the Examiner further asserts that;

Applicant employs broad language, which includes the use of words, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any

narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention.⁴

Applicant respectfully submits that the Examiner's position is flawed for at least the following reasons.

First, it is well established that Applicants are entitled to draft claims as broadly as supported by the specification. Second, contrary to the Examiner's assertion, Applicant does not have to argue a narrower interpretation of the claims or amend the claims to construe a narrower meaning or interpretation of the limitations. Third, although it may be true that during examination the claims may be broadly interpreted in light of the specification, Applicant notes that the standard for claim interpretation is not the broadest possible meaning of the claim terms, but rather the broadest *reasonable* interpretation consistent with the specification. See MPEP 2111. Applicant submits that the Examiner's interpretation of the claim language is unreasonable since the claimed data management device certainly does not read on the teachings of Torikka.

In the response, the Examiner further asserts:

When reviewing a reference, the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan

⁴ Page 11 of the Office Action dated June 14, 2007.

would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F.2d 825, 826, 159 U.S.P.Q. (CCPA 1968)⁵

The Examiner appears to reason that one of ordinary skill in the art at the time of invention would have drawn an inference or inferences from Torikka with regard to the claimed invention. However, the Examiner fails to explain in detail what these inferences may be. In re Preda requires “inferences which one skilled in the art would *reasonably* be expected to draw therefrom.” Thus, In re Preda teaches that a subjective standard is to be used based on the entire disclosure of Torikka, including sections of this reference that reasonably teach away from the Examiner’s unstated inference. Applicant submits that it would not have been a *reasonable* inference for one of ordinary skill in the art at the time of invention, to have considered a data management device which takes control of at least a portion of resources of a base station instead of a terrestrial node to enable transfer of data between a traffic node and the base station based on the disclosure of Torikka in its entirety. First, as discussed above, Torikka does not teach or suggest the claimed data management device. Second, the use of a system which reconfigures resources capable of handling or processing various kinds of services , or reconfigures the functionality of a node of the system by modifying software in a board unit of the node purports no such inference of a data management device as claimed.

The Examiner further asserts:

Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person skilled in the art without any specific

⁵ Page 9 of the Office Action dated June 14, 2007.

hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1069).⁶

The Examiner's reliance on *In re Jacoby* and *In re Bozek*, in the context of a rejection under 35 U.S.C. § 102(e) is not understood, since each of the cited cases addresses issues involving obviousness, not anticipation. See *In re Opprecht*, 12 U.S.P.Q.2d 1235 (Fed. Cir. 1989). However, since the Examiner raises these cases as somehow being dispositive towards resolution of the issues, Applicant will respond below as if the Examiner had rejected claim 1 under 35 U.S.C. § 102(b)/§103 based on *Torikka*.

In re Jacoby stands for the proposition that one of ordinary skill in the art is presumed to have knowledge outside of that disclosed in the reference. Thus, it was considered immaterial that the reference applied in that case did not disclose a function found in the specification since *the actual structure itself was disclosed*. In contrast, *Torikka* does not disclose a structure capable of performing the function of taking local control, on command, of at least a portion of the resources of a base station, instead of a terrestrial node, to enable transfer of data between a traffic source and the base station.

In re Bozek stands for the proposition that the Examiner can use a reference to establish the knowledge level in the art. Once that level is established, the Examiner can determine obviousness from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

With respect to claim 1, the Examiner's analysis clearly fails in applying *In re Bozek*. The case indicates that the Examiner is permitted to apply a reference to establish that specific

⁶ Page 10 of the Office Action dated June 14, 2007.

knowledge is in the art. In the present rejection of claim 1, it is the Examiner's analysis which is used to show the data management device, not an applied reference.

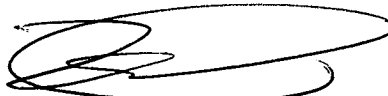
Further, Karabinis does not cure the deficiencies of Torikka.

Accordingly, Applicant respectfully submits that claim 1 should be allowable because the cited references do not teach or suggest all of the features of the claim. Claims 2-21 should also be allowable at least by virtue of their dependency on independent claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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